

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.:	09/937,331	Examiner: Toby Glen Sohoo
Filing Date:	September 21, 2001	Group Art Unit: 1723
Inventor:	Kunze et al.	Attorney Docket No. 72.053
Assignee:	Wacker Construction Equipment AG	
Invention:	<i>Internal Vibrator with a Measuring System</i>	
Priority:	Int'l Appl. No. PCT/EP00/02138; filed 10 March 2000 German Appl. Ser. No. 199 13 077.9; Filed 23 March 1999	

REQUEST FOR PRE APPEAL BREIF CONFERENCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed December 18, 2006, please consider the following remarks with respect to the allowability of the above-captioned application. The Office is hereby authorized to charge Deposit Account 50-1170 the amount of \$950.00 which includes \$450.00 dollars for a two-month extension of time and \$500.00 as the fee associated with the enclosed Notice of Appeal.

The Application and claims pending appeal are as amended in the Response filed October 6, 2006. Accordingly, the claims are not reproduced herein. As set forth below, the Examiner's basis of rejecting the present application relies on several improper interpretations and applications of the rules. Appellant respectfully requests the Panels consideration of the following remarks with respect to the patentability of the pending application.

REMARKS

Although Appellant appreciates the Examiner's citation to portions of the MPEP, 37 C.F.R., and 35 U.S.C. as they relate to claims of priority under 35 U.S.C. §§119, 172, and 365, Appellant directs the Examiner's attention to the application filing papers. In these papers it is indicated that this application is a national stage application filed under 35 U.S.C. §371 and in which included "an English-language translation of the international application has filed." MPEP §201.15 requires that "if the priority papers are already in the file when the Examiner finds a reference with the intervening effective date, the Examiner will study the papers, if they are in the English language, to determine if the applicant is entitled to their date." Appellant finds it improbable, if not completely unlikely, that the Examiner has studied these filing papers as required by MPEP §201.15.

As further stated in MPEP §201.15, "if at the time of making in it action the Examiner has found [] an intervening reference, he or she simply rejects whatever claims may be considered unpatentable thereover, without paying any attention to the priority date (assuming the papers have not yet been filed)." MPEP §201.15 further states that, "the applicant in his or her reply may argue the rejection if it is of such a nature that it can be argued, **or** present the foreign papers for the purpose of overcoming the date of the reference." "If the applicant argues the reference, the Examiner, **in a next action** in the application, may specifically require the foreign papers to be filed in addition to repeating the rejection if it is still considered applicable, or he or she may merely continue the rejection." MPEP §201.15.

First, Appellant has never been afforded an opportunity to respond to this reference without being unduly required to furnish what is already been provided. Second, the Examiner's insistence upon being provided an English-language translation of the foreign priority document (which corresponds to the international application and which was filed under 35 U.S.C. §371 with a copy of the international application in the English language) includes an English-language translation of the international application which was provided in the English language prior to the apparent earliest publication dates of Steffen USP 6,084,327 or the family of

references associated with Stephen USP 6,544,025. These are the Examiner's first and second clear errors in the outstanding Office Action.

The Examiner objected to claim 13 stating that "the typographical error should be corrected to state 'parameter that'." Appellant assumes that the Examiner is referring to the appearance of an omitted space between these terms in the fifth clause of claim 13. The Examiner is hereby authorized to make such a correction by Examiner's amendment. Alternatively, Appellant will correct the typographical error to remove issues from appeal should the Panel disagree with Appellant's reasons for insisting upon the allowability of the above-captioned matter.

In paragraphs 5-7 of the Office Action, the Examiner reiterates a number of claim elements and provides an assertion as to the clear understanding of these claim elements. Particularly with respect to paragraph 7, the Examiner's interpretation of the claims disregards elements that are explicitly called for therein. That is, the Examiner asserts that "issues of the scope of the particular type of motion 'that corresponds to a change in densified state of material' is deemed as being directed to the intended use and interpretation of the signal by a user." As stated in MPEP §2173.05(g), "A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." That is, the Examiner is not free to disregard, assign levels of disregard, or otherwise arbitrarily assign interpretations to claim limitations. Each and every limitation of a claim must be considered in assessing the applicability of the claims to the art of record. A third clear error in the Office Action of December 18, 2006 is the Examiner's refusal to consider each and every element called for in the claims as required by MPEP §2173.05.

In the Office Action of December 18, 2006, the Examiner set forth four (4) separate §103(a) rejections. As with the priority rejection, the Examiner's rejection of the pending claims disregards several tenets of U.S. patent practice. That is, the Examiner's subverted assertions with respect to claim elements and the art of record appears to be a wholly self-serving attempt to fit the pending claims to the previously disclosed work of the assignee of the above-referenced

application. No interpretation of the art of record is required. The art of record simply does not teach, disclose, or suggest that which is set forth in the pending claims. Claim 13 calls for, in part, a poker vibrator having an evaluation circuit that evaluates measured values detected by the measurement device and that produces a signal based on a measured change in the operating parameter that corresponds to a change in a densified state of the material. Claim 13 further requires that the measurement device detects at least one operating parameter of the poker vibrator that is selected from the group consisting of a motion of the vibration unit, an oscillatory amplitude of the vibration unit, and an oscillatory frequency of the vibration unit. Claim 13 further specifies There is no comparable device disclosed, taught, or suggested in the prior art references, alone or in combination with one another.

Stephen '327 discloses (and claims) a vibration device that is constructed to operate with current provided from a transformer secured to a power supply cord. There is no disclosure in Steffen '327, or the other art of record, for a concrete material consolidation device which is constructed to assess and display the degree of consolidation of a pour material. None of the art of record overcomes this short coming. For example, Muira et al. discloses a viscosity and specific gravity detection tool wherein the vibrator serves as both a drive source and a sensor. This disclosure cannot simply be ignored because it doesn't comport with the Examiner's strained application of the reference to the pending claims. One of ordinary skill in the art would readily appreciate that such a configuration would be rendered useless with respect to pouring concrete. There is no suggestion or teaching in Stephen '327, Muira et al., or the other art of record for the formation of a poker vibrator with a consolidation detection assembly configured to monitor vibration operation based on operation of the vibration unit as called for in the present claims.

Claim 13 further calls for a mounting unit that is integrated into the protective and operating tube and that accommodates the frequency converter, an operating switch and a measurement device. The protective and operating tube is further defined in claim 13 as housing the vibration flask of the housing unit. The combination of any of the references of record simply fails to teach, suggest, or disclose a poker vibrator assembly as called for in the present

Response to Office Action dated June 29, 2006
U.S. Application No.: 09/937,331; filed September 21, 2001
Inventor: Kunze et al.
Page 5

claims. Even the combination of Stephen '327 and Muira et al. fails to teach or suggest that which the Examiner alleges is disclosed therein. Simply, it seems apparent that the pending application has been impermissibly used as an instruction manual in assembling a hodge-podge of references in an attempt to yield the claimed invention. Where the references omit claim limitations, those limitations are subverted in an attempt to correspond to other features of the references.


Assuming arguendo that, for example, Stephen '327 and Muira et al. are combinable, the reasonable combination of Stephen '327 and Muira et al. would yield an assembly having a vibration detection unit mounted proximate the control. However, the control of the vibrator of Stephen '327 is mounted on the cord and is remote from the vibrating unit. One of ordinary skill in the art would appreciate that such a configuration would not assess the consolidation of the working material. The Examiner has simply disregarded the operation and association of the elements of the claims that cannot be found in the art of record. There is no disclosure in the art of record for a poker vibrator that operates and is constructed as specified in claim 13. The Examiner's strained interpretation of the references as well as the complete disregard for certain elements of the claims clearly evidences the art of records failing to teach, suggest, or disclose that which is called for in the present claims.

A review of the claims and the art of record, as a whole, clearly evidences the Examiner's final failing in establishing a *prima facie* obviousness rejection. Accordingly, the Panel's favorable consideration and a Notice of Allowance are respectfully requested. Should the Examiner or Panel consider any fees beyond those addressed above to be payable in conjunction with this or any future communication, the Director is authorized to direct payment of such fees, or credit any overpayment to Deposit Account No. 50-1170.

Date: May 18, 2007

Customer No. 23598
BOYLE FREDRICKSON et al.
250 East Wisconsin Avenue, Suite 1030
Milwaukee, WI 53202
Telephone: (414) 225-9755
Facsimile: (414) 225-9753

Respectfully submitted,



Timothy E. Newholm
Registration No. 34,400